

REMARKS/ARGUMENTS

Applicant has reviewed the detailed non-final Office Action mailed August 7, 2008 (paper no. 20080731). Previously, claims 70, 72, 75-86, and 88 were elected with traverse; claims 1-69, 71, 73, 74, 87, and 89-98 have been withdrawn. In the outstanding Office Action, claims 72, 75-77, 82, and 84 were rejected under 35 U.S.C. § 112 second paragraph, claims 70, 72, 75-77, 79-86, and 88 were rejected under 35 U.S.C. § 102, and claims 78 and 83 were rejected under 35 U.S.C. §103(a). In this paper, claims 70, 72, 75-77, 81, 82, and 85 have been amended, no new matter has been added. No claims have been added or cancelled. Thus, upon entry of this response, claims 70, 72, 75-86, and 88 will be pending in this application. A three-month extension of time is requested with the entry of this Response.

Applicant requests reconsideration of the pending claims in view of the following remarks. Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers.

Claim Rejections Under 35 U.S.C. §112

In the outstanding Office Action, claims 72, 75-77, 82, and 84 were rejected under 35 U.S.C. § 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims have been carefully reviewed in light of the Examiner's comments and amended as necessary. Following this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

Claim Rejections Under 35 U.S.C. §102

In the outstanding Office Action, claims 70, 72, 75-77, 79-86, and 88 were rejected under 35 U.S.C. § 102. Specifically, claims 70, 72, 75-77, 79-86, and 88 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 4,909,382 to Cuppari (herein after referred to as “Cuppari”), and claims 70, 72, 75-77, 79-82, 84-86, and 88 were rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Pat. No. 6,382,409 to Scala (hereinafter referred to as “Scala”). For the following reasons, Applicant respectfully traverses these rejections.

I. Claims 70, 72, 75-77, 79-86, and 88 are Patentable Over Cuppari

In the outstanding Office Action, claims 70, 72, 75-77, 79-86, and 88 were rejected as being anticipated by Cuppari. For at least the following reasons, Applicant respectfully traverses the rejection.

Regarding claim 70 as amended, recites:

A reusable holder for contact lens cases comprising:

- a) a lid;
- b) a base;
- c) one or *more receptacles for a contact lens case*; and

d) a time keeping device; wherein the time keeping device comprises an indicator for each one or more receptacles that *indicates a period of time that has elapsed since the contact lens case currently in the receptacle was placed therein to denote a need to discard said contact lens case and a contact lens associated with said contact lens case.*
(Emphasis added).

As illustrated above, claim 70 recites a holder configured to retain contact lens cases while simultaneously providing a timer that indicates to a user when the useful life of a contact lens and its associated lens case has expired. As noted in the specification, there has been little attention given to the need to replace contact lens storage cases. See Specification, [0157].

In contrast, Cuppari utterly fails to provide a reusable holder for contact lens cases including a timer configured to indicate to a user when the useful life of a contact lens and its associated lens

case has expired. Rather, Cuppari discloses a contact lens carrying case that includes a timer with an alarm for timing the disinfecting and rinsing cycles. *See Cuppari, Abstract.* In the example provided in Cuppari, a platinum catalyst such as AO DISC® is used to disinfect a lens in around 6 hours. Consequently the alarm is set for at least 6 hours. *See Cuppari, col. 3 lines 11-17.* There is absolutely no teaching or suggestion in Cuppari of an indicator that indicates a need to discard a contact lens case and a contact lens associated therewith.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, because Cuppari fails to set forth each and every element of independent claim 70, as explained above, the rejection of independent claim 70, and all claims that depend there from, under 35 U.S.C. § 102 based on Cuppari should be reconsidered and withdrawn.

Similarly, Cuppari utterly fails to teach, suggest, or otherwise disclose the elements claimed in dependent claims 81 and 85. First, dependent claims 81 and 85 depend from and necessarily include the claim limitations of independent claim 70. Consequently, the arguments made above are equally applicable to dependent claims 81 and 85. In addition, dependent claim 81 recites "[t]he holder of claim 70 wherein the indicator shows the period of time that has elapsed changing from a first color to a second color, wherein said second color denotes a need to discard said contact lens case and a contact lens associated with said contact lens case." There is absolutely no teaching or suggestion in Cuppari of an indicator having a color changing element wherein the changing of a color element from one color to another color indicates a need to discard a contact lens case and its associated contact lens. In fact, the word "color" is not even included in Cuppari.

Similarly, dependent claim 85, as amended, recites '[t]he holder of claim 70 further comprising: *a mechanical timer reset switch* disposed in said one or more receptacles; wherein said mechanical timer reset switch is *configured to automatically reset the time keeping device when a contact lens case is inserted into the receptacle.* (Emphasis added). In contrast to dependent claim 85, Cuppari fails to teach or otherwise suggest a timer reset switch configured to automatically reset

the time keeping device when a contact lens case is inserted into the receptacle. Rather, Cuppari teaches a manual button adjustment process to adjust the alarm timer of Cuppari.

Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, because Cuppari fails to set forth each and every element of dependent claims 81 and 85, as explained above, the rejection of dependent claims 81 and 85, and all claims that depend there from, under 35 U.S.C. § 102 based on Cuppari should be reconsidered and withdrawn.

II. Claims 70, 72, 75-77, 79-82, 84-86, and 88 are Patentable Over Scala

In the outstanding Office Action, claims 70, 72, 75-77, 79-82, 84-86, and 88 were rejected as being anticipated by Scala. For at least the following reasons, Applicant respectfully traverses the rejection.

Regarding claim 70 as amended, recites:

A reusable holder for contact lens cases comprising:

- a) a lid;
- b) a base;
- c) one or *more receptacles for a contact lens case*; and
- d) a time keeping device; wherein the time keeping device comprises an indicator for each one or more receptacles that *indicates a period of time that has elapsed since the contact lens case currently in the receptacle was placed therein to denote a need to discard said contact lens case and a contact lens associated with said contact lens case*.

(Emphasis added).

As illustrated above, claim 70 recites a holder configured to retain contact lens cases while simultaneously providing a timer that indicates to a user when the useful life of a contact lens and its associated lens case has expired. As noted in the specification, there has been little attention given to the need to replace contact lens storage cases. See Specification, [0157].

In contrast, Scala utterly fails to teach, suggest, or otherwise disclose a reusable holder for contact lens *cases* including a timer configured to indicate to a user when the useful life of a contact lens and its associated lens case has expired. Rather, Scala discloses a contact lens carrying case itself that includes a time tracking structure configured for tracking a time associated with the contact lens contained within the contact lens case. *See Scala Abstract.* In contrast to independent claim 70, Scala absolutely does not teach, suggest, or otherwise disclose the discarding of a case along with the contact lens. In fact, Scala actually teaches away from discarding a contact lens case by teaching a reusable contact lens case with expensive or highly detailed time tracking functions. *See Scala, col. 9, lines 5-22.* This actually exacerbates the problem associated with a contact lens wearer not replacing their contact lens case. There is absolutely no teaching or suggestion in Scala of an indicator that indicates a need to discard a contact lens case and a contact lens associated therewith.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)* (emphasis added). See M.P.E.P. § 2131. Consequently, because Scala fails to set forth each and every element of independent claim 70, as explained above, the rejection of independent claim 70, and all claims that depend there from, under 35 U.S.C. § 102 based on Scala should be reconsidered and withdrawn.

Similarly, Scala utterly fails to teach, suggest, or otherwise disclose the elements claimed in dependent claims 81 and 85. First, dependent claims 81 and 85 depend from and necessarily include the claim limitations of independent claim 70. Consequently, the arguments made above are equally applicable to dependent claims 81 and 85. In addition, dependent claim 81 recites "[t]he holder of claim 70 wherein the indicator shows the period of time that has elapsed changing from a first color to a second color, wherein said second color denotes a need to discard said contact lens case and a contact lens associated with said contact lens case." There is absolutely no teaching or suggestion in Scala of an indicator having a color changing element wherein the changing of a color element from a first color to a second color indicates a need to discard a contact lens case and its associated contact lens. In fact, the word "color" is not even included in Scala. The outstanding

Office Action states that “the indicator shows the period of time that has elapsed by changing from one color to another (since the numbers on the display have a color, as the numbers change, the color on the display is changing).” Office Action, p. 5. This argument is baseless in that claim 81 recites changing from a first color to a second, color, the second color denoting a need to discard a contact lens case and its associated contact lens. There is no teaching, suggestion, or other disclosure to indicate that a color is used to indicate a need to discard a case and a lens.

Similarly, dependent claim 85, as amended, recites ‘[t]he holder of claim 70 further comprising: *a mechanical timer reset switch* disposed in said one or more receptacles; wherein said mechanical timer reset switch is *configured to automatically reset the time keeping device when a contact lens case is inserted into the receptacle*. (Emphasis added). In contrast to dependent claim 85, Scala fails to teach or otherwise suggest a timer reset switch configured to automatically reset the time keeping device when a contact lens case is inserted into the receptacle. Rather, Scala teaches a manual wheel or button adjustment process to adjust the time keeping device of Scala. *See* Scala, col. 9, lines 5-22.

Again, “[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, because Scala fails to set forth each and every element of dependent claims 81 and 85, as explained above, the rejection of dependent claims 81 and 85, and all claims that depend there from, under 35 U.S.C. § 102 based on Scala should be reconsidered and withdrawn.

Claim Rejections Under 35 U.S.C. §103

In the outstanding Office Action, claims 78 and 83 were rejected under 35 U.S.C. §103(a). Specifically, 1. claim 78 was rejected under 35 U.S.C. §103(a) as being unpatentable over Cuppari in view of U.S. Pat. No. 5,699,900 to Artis (hereinafter referred to as “Artis”), 2. claim 78 was rejected under 35 U.S.C. §103(a) as being unpatentable over Scala in view of Artis, and 3. claim 83

was rejected under 35 U.S.C. §103(a) as being unpatentable over Scala. For at least the following reasons, Applicant respectfully traverses the rejections.

I. Claim 78 Is Patentable over Cuppari in view of Artis

With regard to dependent claim 78 being rejected as unpatentable over Cuppari in view of Artis, claim 78 recites: “[t]he holder of claim 70 wherein the time keeping device comprises an LCD indicator.”

Dependent claim 78 depends from, and necessarily includes the claim elements of independent claim 70. Consequently, the arguments made above with regard to Cuppari utterly failing to teach, suggest, or otherwise disclose each and every element of independent claim 70 are equally applicable here. That is, Cuppari utterly fails to provide a reusable holder for contact lens cases including a timer configured to indicate to a user when the useful life of a contact lens and its associated lens case has expired. Rather, Cuppari discloses a contact lens carrying case that includes a timer with an alarm for timing the disinfecting and rinsing cycles. *See Cuppari, Abstract.* In the example provided in Cuppari, a platinum catalyst such as AO DISC® is used to disinfect a lens in around 6 hours. Consequently the alarm is set for at least 6 hours. *See Cuppari, col. 3 lines 11-17.* There is absolutely no teaching or suggestion in Cuppari of an indicator that indicates a need to discard a contact lens case and a contact lens associated therewith.

Furthermore, Artis fails to remedy the shortcomings of Cuppari. Specifically, Artis teaches a contact lens storage device that displays the number of days that a contact lens has been worn by a wearer. *Artis Abstract.* However, Artis actually teaches away from discarding a contact lens case by teaching a reusable contact lens case with a detailed time tracking functions. *See Artis, col. 3, lines 62-67.* This actually exacerbates the problem associated with a contact lens wearer not replacing their contact lens case. There is absolutely no teaching or suggestion in Artis of an indicator that indicates a need to discard a contact lens case and a contact lens associated therewith.

Furthermore, under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, patent examiners must consider (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art, (3) the level of ordinary skill in the pertinent art, and (4) objective evidence relevant to the issue of obviousness. In

the present case, the scope of Cuppari in view of Artis does not in any way suggest or disclose an indicator that indicates a need to discard a contact lens case and a contact lens associated therewith. Rather, Cuppari in view of Artis teaches a re-usable lens case, contrary to the claimed elements.

A reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that point toward the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). Furthermore, it is well known that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Consequently, because Cuppari in view of Artis fails to teach, suggest, or disclose each and every element of independent claim 70 and actually teach away from the claimed elements, as explained above, the rejection of dependent claim 78 under 35 U.S.C. § 103 based on Cuppari in view of Artis should be reconsidered and withdrawn.

II. Claim 78 Is Patentable over Scala in view of Artis

With regard to dependent claim 78 being rejected as unpatentable over Scala in view of Artis, dependent claim 78 depends from, and necessarily includes the claim elements of independent claim 70. Consequently, the arguments made above with regard to Scala utterly failing to teach, suggest, or otherwise disclose each and every element of independent claim 70 are equally applicable here. That is, Scala utterly fails to teach, suggest, or otherwise disclose a reusable holder for contact lens *cases* including a timer configured to indicate to a user when the useful life of a contact lens and its associated lens case has expired. Rather, Scala discloses a contact lens carrying case itself that includes a time tracking structure configured for tracking a time associated with the contact lens contained within the contact lens case. *See* Scala Abstract. In contrast to independent claim 70, Scala absolutely does not teach, suggest, or otherwise disclose the discarding of a case along with the contact lens. In fact, Scala actually teaches away from discarding a contact lens case by teaching a reusable contact lens case with expensive or highly detailed time tracking functions. *See* Scala, col. 9, lines 5-22. This actually exacerbates the problem associated with a contact lens wearer not replacing their contact lens case. There is absolutely no teaching or suggestion in Scala

of an indicator that indicates a need to discard a contact lens case and a contact lens associated therewith.

Furthermore, Artis fails to remedy the shortcomings of Scala. Specifically, Artis teaches a contact lens storage device that displays the number of days that a contact lens has been worn by a wearer. *See Artis Abstract*. However, Artis actually teaches away from discarding a contact lens case by teaching a reusable contact lens case with a detailed time tracking functions. *See Artis*, col. 3, lines 62-67. This actually exacerbates the problem associated with a contact lens wearer not replacing their contact lens case. There is absolutely no teaching or suggestion in Artis of an indicator that indicates a need to discard a contact lens case and a contact lens associated therewith.

Furthermore, under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, patent examiners must consider (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art, (3) the level of ordinary skill in the pertinent art, and (4) objective evidence relevant to the issue of obviousness. In the present case, the scope of Scala in view of Artis does not in any way suggest or disclose an indicator that indicates a need to discard a contact lens case and a contact lens associated therewith. Rather, Scala, both alone and in view of Artis teaches a re-usable lens case, contrary to the claimed elements.

A reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that point toward the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). Furthermore, it is well known that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Consequently, because Scala in view of Artis fails to teach, suggest, or disclose each and every element of independent claim 70 and actually teach away from the claimed elements, as explained above, the rejection of dependent claim 78 under 35 U.S.C. § 103 based on Scala in view of Artis should be reconsidered and withdrawn.

III. Claim 83 Is Patentable over Scala

With regard to claim 83 being unpatentable under 35 U.S.C. §103(a) over Scala, applicant respectfully disagrees. Specifically, dependent claim 83 depends from and necessarily includes the claim elements of independent claim 70. that is, the arguments made above with regard to Scala failing to teach, suggest, or otherwise disclose the elements of independent claim 70 are equally applicable here. Specifically, Scala utterly fails to teach, suggest, or otherwise disclose a reusable holder for contact lens *cases* including a timer configured to indicate to a user when the useful life of a contact lens and its associated lens case has expired. Rather, Scala discloses a contact lens carrying case itself that includes a time tracking structure configured for tracking a time associated with the contact lens contained within the contact lens case. *See Scala Abstract.* In contrast to independent claim 70, Scala absolutely does not teach, suggest, or otherwise disclose the discarding of a case along with the contact lens. In fact, Scala actually teaches away from discarding a contact lens case by teaching a reusable contact lens case with expensive or highly detailed time tracking functions. *See Scala, col. 9, lines 5-22.* This actually exacerbates the problem associated with a contact lens wearer not replacing their contact lens case. There is absolutely no teaching or suggestion in Scala of an indicator that indicates a need to discard a contact lens case and a contact lens associated therewith.

A reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that point toward the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). Furthermore, it is well known that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Consequently, because Scala fails to teach, suggest, or disclose each and every element of independent claim 70 and actually teach away from the claimed elements, as explained above, the rejection of dependent claim 83 under 35 U.S.C. § 103 based on Scala should be reconsidered and withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant has authorized payment for a three month extension of time with this response. Applicant believes no other fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 40302-0033 from which the undersigned is authorized to draw.

Respectfully submitted,

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